

Appl. No. : **09/574,736**
Filed : **May 18, 2000**

REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider U.S. Patent Application Serial No. 09/574,736, entitled "Remote Computer Controller and Control Method", and filed May 18, 2000 in view of the following comments.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1, 2, 5, 7, and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,675,300, to Jung (hereinafter "Jung") in view of U.S. Patent No. 6,289,464 to Wecker et al. (hereinafter "Wecker") in view of U.S. Patent No. 6,396,438 to Seal (hereinafter "Seal") and further in view of U.S. Patent No. 6,392,534 to Flick (hereinafter "Flick").

Further, in the Office Action, the Examiner rejected Claims 8-9, 11-12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Jung in view of Flick and further in view of Wecker.

Applicant submits herewith Rule 131 Declarations and corresponding appendices to overcome the Jung patent. Specifically, Applicant submits *Declaration Under 37 C.F.R. § 1.131* by Michael V. Leman, a joint inventor. Applicant does not submit in this Reponses a Rule 131 Declaration by the other named inventor, William Creese, because the other joint inventor cannot be reached despite diligence by the Applicant. However, a declaration signed by only one inventor is sufficient, where it is shown that another joint inventor is deceased, refuses to sign, or is otherwise unavailable. M.P.E.P § 715. Thus, Applicant submits herewith declarations by Peter Sun and Sheila Deschenes, employees at Knobbe, Martens, Olson & Bear, LLP, who diligently attempted, but were ultimately unable, to contact William Creese to obtain a Rule 131 Declaration from him.

Additionally, Applicant hereby incorporates by reference a previously submitted *Declaration Under 37 C.F.R. § 1.131* by Tom Arno, attorney, dated February 17, 2005, directed to establishing the date of the invention. Applicant submits herewith a supplemental *Declaration Under 37 C.F.R. § 1.131* by Tom Arno dated May 18, 2005. This supplemental *Declaration* includes further documentary evidence to show conception at a date earlier than the Jung patent, and further discusses the diligence of the attorney in preparing the patent application.

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Applicant notes that in the *Declaration Under 37 C.F.R. § 1.131* by Tom Arno dated February 17, 2005, there is a typographical error in paragraph 5. The error occurs in the sentence “To my knowledge, on February 29, 2000, William Creese provided to Nancey Hammond, a legal assistant of Micron Electronics, certain requested changes to the draft application, i.e., Appendix A.” However, the sentence was meant to say “To my knowledge, on February 23, 2000, William Creese provided to Nancey Hammond, a legal assistant of Micron Electronics, certain requested changes to the draft application, i.e., Appendix A.” (Emphasis added). The typographical error does not alter any of the Applicant’s remarks or arguments, and it does not materially alter the dates necessary to establish prior inventorship.

The *Declarations* includes facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued (37 C.F.R. § 1.131(a)(1) and M.P.E.P § 715). The showing of facts are such, in character and weight, as to establish conception of the invention prior to the effective date of the referenced coupled with due diligence from a date prior to the effective date of the reference to a subsequent filing of the application (37 C.F.R. § 1.131(b) and M.P.E.P § 715).

The features of the invention as cited in independent Claims 1, 5, 8, 11, 14, and 17 were conceived as early as March 13, 2000 in this country. The *Declaration* by Michael Leman shows that the original draft of the application prepared by Tom Arno was given to the inventors for their review prior to March 13, 2000. The features of the above recited Claims appearing in the draft application are identical to the features of the above recited Claims appearing in the filed application. These facts establish that the inventors had conceived of the invention as early as March 13, 2000.

Additionally, reasonable due diligence in reducing the invention to constructive reduction to practice was made from at least prior to March 13, 2000 to at least May 18, 2000, the filing date of the patent application. The diligence of the attorney in preparing and filing the patent application inures to the benefit of the inventor. See *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if the attorney worked reasonably hard on the application during the continuous critical period. It is not necessary that the attorney should drop all other work and concentrate on the particular invention involved. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out

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expeditiously, that is sufficient.). The *Declaration* dated February 17, 2005 by Tom Arno along with the supplemental *Declaration* dated May 18, 2005 show he met the requisite diligence with respect to progress on the application during from at least prior to March 13, 2000 to at least May 18, 2000.

In light of the above, Applicant submits that Jung is removed from use as a reference for claim limitations and this removal enables patentability, even as under § 103. Applicant may overcome a § 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references. M.P.E.P. § 715.02. Here, the Jung application was filed on March 13, 2000. The *Declarations* by Michael Leman and Tom Arno show possession of the whole invention by the inventors as claimed prior to that date and that there was reasonable due diligence through the application filing date. Since the inventors have demonstrated inventorship prior to Jung's filing date, Jung should be removed as a reference for claim limitations. Accordingly, it is submitted that Claims 1, 2, 5, 7-9, 11-12, 14, and 17 cannot be held as unpatentable under § 103. Applicant respectfully requests the withdrawal of all claim rejections and the prompt allowance of the claims.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

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Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6/9/05

By: 

Eric M. Nelson

Registration No. 43,829

Attorney of Record

Customer No. 20,995

(619) 235-8550

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